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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,640	02/07/2001	Babak Nemati		4426
75	10/16/2003		EXAMINER	
Suzannah K Sundby			HAYES, MICHAEL J	
Jacobson Holms 400 Seventh Str			ART UNIT	PAPER NUMBER
	nington, DC 20004-2201		3763	/
			DATE MAILED: 10/16/2003	<i>[</i> S

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)	
Advisory Action	09/777,640	NEMATI, BABAK	$\mathcal{O}$
Advisory Action	Examiner	Art Unit	
	Michael J Hayes	3763	
The MAILING DATE of this communication	appears on the cover sheet with	the correspondence address	S
THE REPLY FILED 11 September 2003 FAILS TO Therefore, further action by the applicant is required final rejection under 37 CFR 1.113 may only be eith condition for allowance; (2) a timely filed Notice of A Examination (RCE) in compliance with 37 CFR 1.11	I to avoid abandonment of this a er: (1) a timely filed amendment Appeal (with appeal fee); or (3) a	pplication. A proper reply to which places the application	a ı in
PERIOD FO	OR REPLY [check either a) or b)]		
a) $\square$ The period for reply expires $\underline{4}$ months from the maili			
b) The period for reply expires on: (1) the mailing date of no event, however, will the statutory period for reply of ONLY CHECK THIS BOX WHEN THE FIRST REPLETOR OF (6)	expire later than SIX MONTHS from the	mailing date of the final rejection.	
706.07(f).  Extensions of time may be obtained under 37 CFR 1.136(a fee have been filed is the date for purposes of determining the pfee under 37 CFR 1.17(a) is calculated from: (1) the expiration of (2) as set forth in (b) above, if checked. Any reply received by the timely filed, may reduce any earned patent term adjustment. See	period of extension and the corresponding tate of the shortened statutory period for the Office later than three months after the	g amount of the fee. The appropriate reply originally set in the final Office	ate extension ce action; or
1. A Notice of Appeal was filed on Appe 37 CFR 1.192(a), or any extension thereof (3	llant's Brief must be filed within t 7 CFR 1.191(d)), to avoid dismis	he period set forth in sal of the appeal.	
2. The proposed amendment(s) will not be ente	red because:		
(a) ⊠ they raise new issues that would require	further consideration and/or sea	arch (see NOTE below);	
(b) ☐ they raise the issue of new matter (see N			
(c) they are not deemed to place the application issues for appeal; and/or	ation in better form for appeal by	materially reducing or simpli	ifying the
(d) they present additional claims without ca	anceling a corresponding number	er of finally rejected claims.	
NOTE: <u>See Continuation Sheet</u> .			
3. Applicant's reply has overcome the following	rejection(s):		
4. Newly proposed or amended claim(s) value canceling the non-allowable claim(s).	would be allowable if submitted i	n a separate, timely filed am	endment
5.⊠ The a) affidavit, b) exhibit, or c) reques application in condition for allowance because	est for reconsideration has been se:	considered but does NOT pl	lace the
6. The affidavit or exhibit will NOT be considere raised by the Examiner in the final rejection.	d because it is not directed SOL	ELY to issues which were ne	ewly
7. For purposes of Appeal, the proposed amend explanation of how the new or amended claim	dment(s) a)⊡ will not be entered ms would be rejected is provided	d or b)⊡ will be entered and d below or appended.	an
The status of the claim(s) is (or will be) as fol	lows:		
Claim(s) allowed:			
Claim(s) objected to:			
Claim(s) rejected:		·	

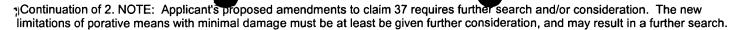
Michael J Hayes **Primary Examiner** Art Unit: 3763

10. Other: \_\_\_\_

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. The proposed drawing correction filed on \_\_\_\_ is a) approved or b) disapproved by the Examiner.

9. Note the attached Information Disclosure Statement(s)( PTO-1449) Paper No(s). \_\_\_\_



Some notes regarding the proposed amendment: with porative means for bypassing recited in independent claim 37, the dependent limitations of abrading, acoustic pressure, optical pressure, temperature gradient, concentration gradient, tissue stripping, and laser ablation do not appear to fall within Applicant's definition of porative bypassing means (See claim 70 and Applicant's specification pg. 19, 2<sup>nd</sup> paragraph). It is not clear whether Applicant's recitation of "delivery means" in section (c) referrs to means for delivering agent or means for delivering light.

Applicant argues that Martinez does not show bypassing barrier with minimal tissue damage. Applicant points out that Martinez must make an incision, but Applicant's porative means also includes abrading (claim 56) and tissue stripping (claim 63). Applicant has not explicitly defined "minimal tissue damage" in the original specification which would allow him to rely on a special definition. The phrase is not adequately defined to establish the metes and bounds of the invention.

Applicant's declaration argues against the modification of the invention of Chan as one device as opposed to two separate devices. Applicant has not recited any structural limitation that relates the combination of the two devices. Combining two separate elements into one element is an obvious modification. See Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

Applicant's declaration concerning the use of the claimed apparatus are relevant to a method of using the apparatus. The apparatus claims read on the prior art because the prior art is capable of performing the recited functions.